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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,489	08/05/2003	William Howard Roark	PC25260A	8667

28880 7590 07/14/2005
WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
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EXAMINER

WARD, PAUL V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,489

Applicant(s)

ROARK, WILLIAM HOWARD

Examiner

PAUL V. WARD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date March 8, 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds according to claim 1, wherein Y^5 is $N(R^5)$. These compounds are classifiable in class 544 or 546, subclass various.
- II. The compounds according to claim 1, wherein Y^5 is CH_2 or $C(O)$. These compounds are classifiable in class 544 or 540, subclass various.
- III. The compounds according to claim 1, wherein Y^5 is O. These compounds are classifiable in class 549, subclass 200+.
- IV. The compounds according to claim 1, wherein Y^5 is S. $S(O)$ or $S(O)_2$. These compounds are classifiable in class 549 or 544, subclass various.
- V. The method according to claims 15-17, wherein Y^5 is $N(R^5)$. This is classifiable in class 514.
- VI. The method according to claims 15-17, wherein Y^5 is CH_2 or $C(O)$. This is classifiable in class 514.
- VII. The method according to claims 15-17, wherein Y^5 is O. This is classifiable in class 514.
- VIII. The method according to claims 15-17, wherein Y^5 is S. $S(O)$ or $S(O)_2$. This is classifiable in class 514.

Inventions of Groups I-IV and Groups V-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with

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another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case. The process for using the product as claimed can be practiced with another materially different product, such as metalloproteinases.

The inventions of Groups I-VIII are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating one member will not render another obvious.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the eight groups designated above would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

A telephone call was made to Claude F. Purchase, Jr. on June 24, 2005 to request an oral election to the above restriction requirement, and Purchase provisionally **elected Group I**. Applicant's election, without traverse, of the species in claim 12, in the reply filed on April 26, 2005 is acknowledged.

Accordingly, Groups II-VIII are withdrawn from further consideration pursuant to 37 CFR 1.152(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant is entitled to have the method claims (i.e., Group V), which are commensurate in scope with the elected invention, rejoined if the compound claims are

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allowed. An amendment, which results in the method claims being commensurate in scope with the allowed claims, will be welcomed.

Applicant reserved the right to file a divisional application to the non-elected subject matter.

An action on the merits on Group I (claims 1-14) is contained herein.

Specification

The abstract of the disclosure is objected to because the Abstract is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

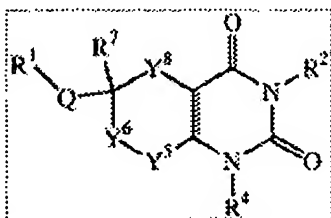
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder (U.S. Patent 3,080,364).

Applicant teaches uracil derivatives having a general formula:



wherein all the variables are as defined in the claims.

Schroeder teaches compounds, which share the same formulaic compounds. The compounds in the said patent has the same structure, which includes Y^5 as $N(R^5)$, Y^6 and $C(O)$, Y^8 as S, $S(O)$, or $S(O)_2$, and Q as $OC(O)$, lower alkyl and alky radicals, and falls within the range of Applicant's compounds. (See col. 1, lines 12-65 and Examples). Since Schroeder teaches the exact compounds, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

2. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Scarborough (U.S. Patent 3,139,432).

Scarborough teaches compounds, which share the same formulaic compounds. (See Formula I, col. 1). The compounds in the said patent has the same structure, which includes R_2 as H or lower alkyl, Y^5 as $N(R^5)$, Y^6 and $C(O)$, Y^8 as CH_2 , and Q as $OC(O)$, lower alkyl and alky radicals, and falls within the range of Applicant's compounds. (See col. 1, lines 12-65 and Table/Examples 2-7 col. 3-4). Since Scarborough teaches the exact compounds, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

3. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Khattab et al. (Journal fur Praktische Chemie Chemiker-Zeitung-1996).

Khattab teaches uracil compounds, which share the same formulaic compounds. (See Abstract). The compounds in the said reference has the same structure, which includes R_2 as H or lower alkyl, Y^5 as $N(R^5)$, Y^6 and $C(O)$, Y^8 as $C(O)$ or CH_2 , and Q as $OC(O)$, lower alkyl and alky radicals, and falls within the range of Applicant's compounds. (See pages 151-153, structures 2a-g, 3, 4-9, and Tables 1-2 on pages

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154-155). Since Khattab teaches the exact compounds, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

4. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Skudarnova et al. (Khimiko-Farmatsevticheskii Zhurnal-1994).

Skudarnova teaches uracil compounds, which share the same formulaic compounds. The compounds in the said reference has the same structure, which includes R_2 as H or lower alkyl, Y^5 as $N(R^5)$, Y^6 and $C(O)$, Y^8 as $C(O)$ or CH_2 , and Q as $OC(O)$, lower alkyl and alkyl radicals, and falls within the range of Applicant's compounds. (See page 39). Since Skudarnova teaches the exact compounds, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder (U.S. Patent 3,080,364).

Schroeder teaches a generic group of uracil derivatives, which embraces Applicants' claimed compounds. (See col. 1 and definitions for X, Y, R and R'). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by

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the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarborough (U.S. Patent 3,139,432).

Scarborough teaches a generic group of uracil derivatives, which embraces Applicants' claimed compounds. (See col. 1 and definitions R). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima

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facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

7. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khattab et al. (Journal fur Praktische Chemie Chemiker-Zeitung-1996).

Khattab teaches a generic group of uracil derivatives, which embraces Applicants' claimed compounds. (See page 151-156 and definitions for R¹, R², R³ and R⁴). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skudarnova et al. (Khimiko-Farmatsevticheskii Zhurnal-1994).

Skudarnova teaches a generic group of uracil derivatives, which embraces Applicants' claimed compounds. (See page 151-156 and definitions for R¹, R², R³ and R⁴). The claims differ from the reference by reciting specific species and a more limited

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genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.


Conclusion

Claims 1-14 are pending. Claims 1-14 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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